



PATENT
Customer No. 22,852
Attorney Docket No. 08702.0100-0000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
WOLFMAN et al.) Group Art Unit: 1646
Application No. 10/071,499) Examiner: Andres, Janet L.
Filed: February 8, 2002)
For: MODIFIED AND STABILIZED GDF)
PROPEPTIDES AND USES)
THEREOF)

#10
M.G.J.
7/10/03

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In a restriction requirement dated May 20, 2003, the Examiner required an election under 35 U.S.C. § 121 from the following groups of claims:

- Group I - Claims 1-20, drawn to GDF-8 polypeptides, classified in class 530, subclass 350;
- Group II - Claims 21-37, drawn to GDF-8 polynucleotides and means of expression, classified in class 435, subclasses 69.1, 320.1, and 325, and class 536, subclass 23.5;
- Group III - Claims 38-59, drawn to methods of treatment with GDF-8 polypeptides, classified in class 424, subclass 198.1;
- Group IV - Claims 60-79 and 90, drawn to BMP-11 polypeptides, classified in class 530, subclass 350;
- Group V - Claims 80-89 and 91-96, drawn to BMP-11 polynucleotides and means of expression, classified in class 435, subclasses 69.1, 320.1, and 325, and class 536, subclass 23.5; and

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Group VI - Claims 97-118, drawn to methods of treatment with BMP-11 polypeptides, classified in class 424, subclass 198.1.

Applicants provisionally elect with traverse to prosecute claims of Group I (claims 1-20) drawn to GDF-8 polypeptides. While the Examiner has alleged that the claims are drawn to independent and distinct inventions, she has not shown that it would be a burden to examine the claims together. The law requires that both (1) the inventions are independent and distinct, and (2) there would be a serious burden on the Examiner if restriction was not required. The Examiner has focused on only the first part of this two-part test. In order to properly restrict the groups, the Examiner needs to show that there would be a serious burden in examining the claims together.

As the Examiner indicated, claims of Group I (claims 1-20) and Group IV (claims 60-79 and 90) are classified in the same class and subclass (class 530, subclass 350). Therefore, the art search for Groups I and IV would be co-extensive and examining all claims at once would not impose a serious burden on the Examiner. Accordingly, the restriction requirement should be withdrawn at least with respect to Groups I and IV. MPEP § 803.

No fee is believed to be due with this response. If any fees are necessary, please charge deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 19, 2003

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